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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/868,426
Filing Date: June 15, 2001
Appellant(s): MORRISON ET AL.

Morrison et al
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 15, 2009 appealing from the Office action mailed December 12, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,374,406	HIRATA	4-2002
5,375,235	BERRY ET AL	12-1994

WO 99/35847	WESTLAKE ET AL	6-1999
2003/0188313	ELLIS ET AL	10-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 10-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirata (6,374,406, of record) in view of Westlake et al. (WO 99/35847, of record) and Berry et al. (5,375,235, of record) [Berry].

Regarding claims 10, 17, and 24, Hirata discloses a method and apparatus comprising:

receiving an electronic mail message remotely from a user (col. 5, lines 10-18, 65-67), said electronic mail message comprising an operating command ('control command', col. 6, lines 21-39) and program identification information including a first type of program identification information (col. 7, lines 6-20);

processing said electronic mail message to determine whether said electronic mail message includes said first type of program identification information (col. 6, lines 40-55); and

scheduling an event responsive to said operating command for a program identified by said program identification information without searching program guide information for said program if said electronic mail message includes said first type of program identification information (col. 7, lines 49-53 and col. 9, lines 24-65).

Hirata fails to disclose continuing to process said electronic mail message to determine whether said electronic mail message includes said second type of program identification information only if said electronic mail message does not include said first type of program identification information, searching said program guide information for said program using said program identification information only if said electronic mail message includes said second type of program identification information and does not include said first type of program identification information, and scheduling said event if said program is found during said searching step.

In an analogous art, Westlake teaches automatically scheduling the operation of a video processing apparatus ('automatic implementation' page 34, lines 2-9, of recording or reminder operations, page 26, lines 7-23) by determining if a received electronic mail message includes a second type of program type identification information and searching program guide information for an identified program using said program identification information (such as program title, page 23, lines 14-28) and scheduling said event if said program is found during said search (page 25 line 24 – page 26 line 23), providing the benefit of providing a means for transmitting programming information via an electronic message for programming a video processing apparatus that is less prone to errors possibly made from the transmitter side (page 3 line 17 – page 4 line 26).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method and apparatus disclosed by Hirata to include processing said electronic mail message to determine whether said electronic mail message includes said second type of program identification information if said electronic mail message does not include said first type of program identification information (which would otherwise lead to an error message, see Hirata, col. 6, lines 40-55), searching said program guide information for said program using said program identification information if said electronic mail message includes said second type of program identification information, and scheduling said event if said program is found during said searching step, as taught by Westlake, for the benefit of providing a means for transmitting programming information via an electronic message for programming a video processing apparatus that is less prone to errors possibly made from the transmitter side.

Hirata and Westlake fail to disclose continuing to process the electronic mail message only if the first type of program identification information is not included.

In an analogous art, Berry teaches performing a searching operation, where a search is first performed for a first type of information, and only broadens the search for a second type of information if a match is not found in the first search, providing the benefit of improved speed by avoiding unnecessary searching (wherein a first type of words are highly specific and are located quickly, whereas a second type of words are less specific and require more

processor intensive searching, therefore the type 1 words are given priority, and additional searching is done one if a type 1 word is not found, col. 4, lines 3-9 and col. 5 line 36 - col. 6 line 19).

It would have been obvious at the time to a person of ordinary skill in the art to perform additional searching only if a match is not found in the first search, as taught by Berry, for the benefit of avoiding unnecessary searching, which streamlines the searching for improved efficiency.

Regarding claims, 11, 18, and 25, Hirata, Westlake, and Berry disclose the method and apparatus of claims 10, 17, and 24, wherein said first type of program identification information includes channel and time information for said program (Hirata, col. 7, lines 11-20) and said second type of program identification information includes a name of said program ('title', Westlake, page 23, lines 21-25).

Regarding claims 12, 19, and 26, Hirata, Westlake, and Berry disclose the method and apparatus of claims 10, 17, and 24, wherein said operating command represents one of a request to record said program ('VIDEO Reservation', Hirata, col. 6, lines 33-39) and a request to watch said program (Westlake, page 26, lines 13-23).

Regarding claims 13, 20, and 27, Hirata, Westlake, and Berry disclose the method and apparatus of claims 12, 19, and 26, wherein said video processing apparatus is scheduled to record said program if said operating command represents said request to record said program (Hirata, col. 9, lines 18-30) and said video processing apparatus is scheduled to power on if said operating command represents said request to watch said program (Hirata teaches powering on the video equipment to implement the operating command if it is not already on, col. 9, lines 54-60).

Regarding claims 14, 21, and 28, Hirata, Westlake, and Berry disclose the method and apparatus of claims 10, 17, and 24, further comprising sending a second electronic mail message from said video processing apparatus to said user if said program is not found during said searching step, said second electronic mail message indicating that said electronic mail message included insufficient program identification information (Hirata teaches sending response emails which provide the details of an error if an error is encountered, col. 6, lines 40-55 and fig. 6).

Regarding claims 15, 22, and 28, Hirata, Westlake, and Berry disclose the method and apparatus of claims 10, 17, and 24, but fail to disclose said electronic mail message further comprises a password and further comprising a

step of sending a second electronic mail message from said video processing apparatus to said user if said password is incorrect.

It is notoriously well known in the art to password protect systems for the benefit of user verification, and it would have been obvious at the time to a person of ordinary skill in the art to modify the method and apparatus of Hirata, Westlake, and Berry to include a password in the electronic email message. This would further comprise sending a second electronic mail message from said video processing apparatus to said user if said password is incorrect because Hirata teaches sending response emails which provide the details of an error if an error is encountered (Hirata, col. 6, lines 40-55 and fig. 6).

Regarding claim 16, 23, and 29, Hirata, Westlake, and Berry disclose the method and apparatus of claims 10, 17, and 24, further comprising sending a second electronic mail message from said video processing apparatus if said event is scheduled (Hirata, fig. 7).

(10) Response to Argument

A. The Proposed Combination Of References Fails To Teach OR Suggest All Elements Of The Claimed Invention

Appellant argues that because the combination of Hirata and Westlake does not teach the conditional limitation of only searching a program guide using a second type of information only if said electronic mail message includes said

second type of program identification information and does not include said first type of information, not all of the claim limitations have been met (appeal brief, pages 8-9). Specifically, appellant presents this argument by pointing to the lack of conditional language in the Westlake reference and states: "As such, Westlake is unable to remedy an admitted deficiency of Hirata. Berry is likewise unable to remedy this admitted deficiency of Hirata (the Examiner does not even allege that it can)."

In response, the examiner must note that appellant's dismissal of Berry with regard to the conditional claim language, stating that "the Examiner does not even allege that it can [remedy the deficiency of Hirata]" is the opposite of what the examiner's position actually is. As stated on page 5 of the Final Rejection mailed on December 12, 2008 (and reproduced above under 'Grounds of Rejection'), the examiner stated: "Hirata and Westlake fail to disclose continuing to process the electronic mail message only if the first type of program identification information is not included." In spite of appellant's assertion to the contrary, the examiner admits that Westlake does not teach the conditional limitation of only performing a second search if information of a first type is not found, and in fact relies extensively on Berry to teach this limitation. While Hirata does disclose ceasing to parse an electronic message if a first type of information is found (Hirata, col. 6, lines 33-39), the examiner considered this teaching alone to be insufficient to meet the claimed condition limitation of *continuing* to process the electronic mail message if the first type of information is not found, and thus

introduced Berry who teaches the benefit of performing a second, broader search for information after a first specific search is attempted (Berry, col. 4, lines 15-17 "By comparing a search term with all the keys in the primary keyword index 12a, the keyword index block 12b that the word will be found in will be located, if the word exists at all.")

B. There Is No "Apparent Reason" To Combine The References In The Proposed Manner

Here, appellant argues that modifying Hirata and Westlake in view of the teachings of Berry would defeat one of the primary objectives of Westlake, since the search algorithm of Westlake requires searching for all terms found in the electronic message in the EPG, and modifying Westlake to search for less than all the terms is contrary to what Westlake teaches (appeal brief, pages 9-10).

In response, it is unclear how the appellant arrived at the conclusion that any kind of modification would be done to Westlake's searching algorithm when the combination of Hirata and Westlake is modified in view of Berry. Hirata teaches a first searching algorithm where an electronic message is parsed, searching for a first type of information (a control command, Hirata, col. 6, lines 21-32). Westlake teaches a second searching algorithm where an electronic message is parsed and each term therein (the second type of information) is searched in an EPG (Westlake, page 23, lines 14-20). The modification made in view of Berry to the Hirata and Westlake combination is the circumstances under

which each of these distinct searching algorithms takes place (namely, Hirata's search is performed first, and if no control commands are found, then Westlake's broader searching algorithm is performed), since Berry expressly teaches the benefit of performing a narrow search using specific predefined terms before even trying to search using a broader set (Berry, col. 4, lines 3-12 and col. 6, lines 1-19).

C. The Berry Reference Constitutes "Non-Analogous Art" Under Federal Circuit Law

Here, appellant argues that Berry is both outside of the field of the inventor's endeavor and is not reasonably pertinent to the particular problem with which the inventor was involved (appeal brief, page 11).

In response, the examiner must disagree, given that the particular problem with which the inventor was involved was a matter of implementing a searching algorithm that parses an electronic message and searches a memory for corresponding terms (something also found in both the Hirata and Westlake disclosures). As was stated previously (in the Final Rejection mailed December 18, 2008, pages 2-3), Berry is quite pertinent to this problem, offering a solution that serves as an improvement over the prior art (Berry, col. 2, lines 20-26).

Lastly, regarding claims 15, 22, and 28, over the course of prosecution, the examiner had taken official notice that well known in the art to password

protect systems for the benefit of user verification. The examiner submits Publication No. 2003/0188313 to Ellis et al. (see figs. 40A, 40B, 40E, 41, and paragraph 0029) as evidentiary support of this finding.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Dominic D Saltarelli/

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